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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,700	11/21/2001	Shinpei Okajima	SHM-98-005-5	3833

7590 05/16/2003

DELAND LAW OFFICE  
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EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT PAPER NUMBER

3618

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/001,700

Applicant(s)

Okajima et al.

Examiner

Vanaman

Art Unit

3618



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 24, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 48-72 and 145-156 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-57, 63-72, and 145-147 is/are allowed.
- 6) ☒ Claim(s) 48, 49, 60, 61, 148-150, and 153 is/are rejected.
- 7) ☒ Claim(s) 50, 58, 59, 62, 151, 152, and 154-156 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **Status of Application**

1. Applicant's amendment, filed Feb 24, 2003, has been entered in the application. Claims 48-72 and 145-156 are pending.

### **Claim Rejections - 35 USC § 103**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 48, 49, 60, 61, 148, 149, and 153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cubberley (US 3,471,161, cited by applicant). Cubberley teaches a binding system for connecting a boot having a cleat with front (26) and rear (12) portions, to a binding having a front main portion (A) and a rear main portion (B), the portions including fixing plates (13, 32) which have apertures for accommodating screws (18) for attachment of the portions to a ski (10); the rear portion having a pivotal latch (41) including an element (42) with a notch, which engages the rear cleat portion when the binding is in an engaged condition, a spring (38) biasing the latch to the engaged position, the latch pivoting on a pivot axis (43) which does not move, and including an over center arrangement biased by the spring to prevent unintended release of the latch (col. 6, lines 4-23), the cleat having a front notch (26) which engages a projecting portion (27) which receives the cleat.

The reference to Cubberley fails to teach the projecting portion 27 on the cleat and the opening 26 on the front binding portion. The reversal of functional elements is considered to be within the skill of the ordinary practitioner in the art, particularly when the function of the device would not be impeded or compromised by the reversal, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to locate the projecting portion on the cleat and the opening on the front main portion for the purpose of allowing an easier guiding of the front end of the cleat into engagement with the binding.

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The reference of Cubberley fails to explicitly teach the binding as being adapted to connect a boot to a snowboard. It is well established that ski bindings may be used in certain snowboard environments, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the binding taught by Cubberley to be used to connect a boot to a snowboard, further, recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As regards claim 61, the provision of elongated mounting apertures in the ski- and snowboard-binding arts is very old and well known, and it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the openings in an elongated form to allow for adjustment of the positions of the binding portions.

4. Claims 148, 149, 150 and 153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyre (US 5,116,074, cited by applicant). Peyre teaches a binding mechanism for connecting a boot (25), having a cleat (26), to a board (1) including a front body (6) connectable to the board and including a cleat receiving opening (28); a rear body (7) connectable to the board, a latch (23) pivotally connected to the rear body (through a pivot axle 22, which does not move forwardly or rearwardly with respect to the rear body in use) and including a notch (underside of 21) which engages a rear tab of a cleat (26), and a spring (14, 14) connected to the rear body which biases the latch to an engaged position (see figure 2-- note that the spring biases 7 forwardly, causing head 19, mounted on sliding shaft 18, and latch face portion 20 to engage, resulting in the latch being urged to the engaged position); a fixing plate (2) for connecting the front and rear bodies to the board (1).

The reference of Peyre fails to explicitly teach the binding as being adapted to connect a boot to a snowboard. It is well established that ski bindings may be used in certain snowboard

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environments, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the binding taught by Peyre to be used to connect a boot to a snowboard, further, recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

#### **Allowable Subject Matter**

5. Claims 50, 58, 59, 62, 151, 152, 154-156 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 51-57, 63-72 and 145-147 are allowed.

#### **Response to Comments**

7. Applicant's comments concerning the amendment to claim 48 and the reference to Peyre have been carefully considered and are persuasive. The examiner agrees that Peyre does not teach each and every limitation set forth in this claim, nor would a modification of the reference to meet the claim limitation be possible, in that such a modification would result in the mechanism of the reference becoming inoperable.

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**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

As of May 1, 2003, any response to this action should be mailed to:

Mail Stop \_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;  
informal or draft communications may be faxed to the same number but should be  
clearly labeled "UNOFFICIAL" or "DRAFT")

The Office has also established electronic fax servers for Technology Center 3600 as follows:

703-872-9326 (Official communications)  
703-872-9327 (Official After Final communications)  
703-872-9325 (Customer Service)

**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**

F. Vanaman  
May 14, 2003



5/14/03